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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,211	12/06/2000	Joseph Thomas O'Neil	2000-0356	8625

7590 10/24/2003

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EXAMINER

LY, NGHI H

ART UNIT PAPER NUMBER

2686

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Py

Office Action Summary

Application No.

09/731,211

Applicant(s)

O'NEIL, JOSEPH THOMAS

Examiner

Nghị H. Ly

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 6, it recites "excluding one of the plurality of geographic location samples of the wireless terminal from the step of comparing".

Regarding claim 7, it recites "plurality of geographic location samples that are excluded from the step of comparing corresponds to a plurality of locations along a mass transit route".

However, in the Applicant's specification page 18, lines 3-5 of the present invention, it merely discloses "*comparing merchant location information from the map with user location samples from the buffer 1105*".

Therefore, the above claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5, 9-11, 15-30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Stewart (US 6,546,257).

Regarding claim 1, 10, 19, 20, 30 and 33, Stewart teaches a method of selecting merchants for transmission of advertising information (see column 2, lines 63-67) to a user of a mobile wireless terminal (see fig.1 wireless connection between portable telephone 28 and base station 17), comprising: comparing a plurality of geographic location samples of a wireless terminal with a geographic location of a seller to determine whether the wireless terminal has frequently traveled in proximity to the seller (see column 7, lines 18-27), and if the wireless terminal has frequently traveled in proximity to the seller (see column 5, lines 44-52), selecting the seller as an entity that may be interested in having an advertisement transmitted to a user of the terminal (see column 11, lines 5-21).

Regarding claims 2 and 11, Stewart further teaches determining whether the wireless terminal has frequently traveled in proximity to the seller involves determining whether a predetermined number of the geographic location samples are within a predetermined distance of the seller (see column 2, lines 14-19 and see column 2, lines 58-63).

Regarding claim 3, Stewart further teaches selecting the seller is dependent upon timing information associated with the wireless terminal's travels in proximity to the seller (see column 11, lines 29-53).

Regarding claim 5, Stewart further teaches selecting the seller is dependent upon whether the seller is of the type seller from whom the user is willing to accept advertisements (see column 11, lines 1-28).

Regarding claim 9, Stewart further teaches the plurality of geographic samples of a wireless terminal are represented by latitude and longitude coordinates (see column 7, lines 18-21 and column 7, lines 62-63 "GPS").

Regarding claim 15, Stewart further teaches the advertisement is transmitted using a medium from the group consisting of e-mail, voice mail, facsimile, paper, banner ads and television commercials (see column 12, lines 39-43).

Regarding claim 16, Stewart further teaches the advertisement is transmitted to the user of the wireless terminal in accordance a user delivery preference (see column 10, lines 39-43).

Regarding claim 17, Stewart further teaches the making an offer to the seller to advertise to the user of the wireless terminal (see column 2, lines 63-67 or see column 1, lines 42-63).

Regarding claim 18, Stewart further teaches purging location samples after a predetermined period of time (see column 3, lines 1-4).

Regarding claim 21, Stewart further teaches the selected merchant is a merchant with a location that the commuter frequently travels in proximity of (see column 2, lines 63-67 or column 5, lines 44-52).

Regarding claim 22, Stewart further teaches transmitting information to the selected merchant regarding the frequency with which the commuter is in proximity to a location of the selected merchant (see abstract).

Regarding claim 23, Stewart further teaches providing the selected merchant with an opportunity to advertise to the commuter (see column 1, lines 42-63).

Regarding claim 24, Stewart further teaches the advertisement is presented as the commuter's commute commences (see column 2, lines 63-67).

Regarding claim 25, Stewart further teaches the advertisement is presented during the commuter's commute (see column 5, lines 44-52).

Regarding claim 26, Stewart further teaches the advertisement is presented as the vehicle is approaching a location of the selected merchant (also see column 5, lines 44-52).

Regarding claim 27, Stewart further teaches the advertisement is a multimedia advertisement (see column 6, lines 28-30).

Regarding claim 28, Stewart further teaches the advertisement is presented to the commuter via an audio system in the vehicle (see column 6, lines 31-34).

Regarding claim 29, Stewart further teaches transmitting and receiving are performed over a wireless connection using a data protocol (see fig.1 portable telephone 28 with antenna 30 and see column 11, lines 21-28).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 6,546,257).

Regarding claim 8, Stewart further teaches the geographic location of the seller is determined from latitude and longitude to one of the plurality of geographic location samples of the wireless terminal (see column 7, lines 20-21).

Stewart does not specifically disclose the geographic location of the seller is determined from a map local to one of the plurality of geographic location samples of the wireless terminal. However, those skilled in the art would have appreciated that latitude and longitude can also be used to find a position of a seller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching into the system of Stewart in order to find the location of the seller.

6. Claims 4, 12, 13, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 6,546,257) in view of Calvert (US 6,526,275).

Regarding claim 4, Stewart further teaches claim 1. Stewart does not specifically disclose selecting the seller is dependent upon demographics information of the user of the wireless terminal.

Calvert teaches selecting the seller is dependent upon demographics information of the user of the wireless terminal (see column 9 lines 16-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Calvert into the system of Stewart in order to determine the likelihood that the device user will actually purchase or otherwise obtain their product and, therefore, whether or not to expect a financial return or other benefit from the costs of advertising their products to the device user (see Calvert, column 9, lines 28-34).

Regarding claims 12, 13, 31 and 32, Stewart teaches the method of claims 10 and 30. Stewart does not specifically disclose receiving an indication of the seller's willingness to pay for transmission of the advertisement to the user of the wireless terminal.

Calvert teaches receiving an indication of the seller's willingness to pay for transmission of the advertisement to the user of the wireless terminal (see column 3, lines 34-39 or see column 19, lines 30-36)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Calvert into the system of Stewart in order to allow the user of wireless terminal to know he/she does not have to pay for the advertising fees.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 6,546,257) in view of Chern et al (US 6,456,854).

Regarding claim 14, Stewart teaches the method of claims 10. Stewart does not specifically disclose that the location samples of the wireless terminal are received via a web interface.

Chern teaches the location samples of the wireless terminal are received via a web interface (see column 8, lines 21-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Chern into the system of Stewart so that the location of a mobile telephone device can be obtained through the internet (see Chern, column 1, lines 60-65).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Hymel (US 6,031,467) teaches method and selective call radio for ensuring reception of advertisement message.

b. Baker (US 6,505,046) teaches method and apparatus for distributing location-based message in a wireless communication network.

c. Son (US 6,584,323) teaches control device for displaying a short message in real time in a digital mobile station and method therefor.


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Nghi H. Ly


10/06/03


CHARLES APPIAH
PRIMARY EXAMINER